IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	Barbara J. Boe, et al.
Serial No.:	09/966,845
Filing Date:	September 28, 2001
Confirmation No.:	4972
Group Art Unit:	3622
Examiner:	Yehdega Retta
Title:	SYSTEM AND METHOD FOR PROFILING CUSTOMERS FOR TARGETED MARKETING

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

REQUEST FOR PRE-APPEAL BRIEF REVIEW

In response to the Advisory Action mailed November 28, 2006, Applicant respectfully requests a Pre-Appeal Brief review of this Application so that the rejection of the claims and the objections to the Application can be reconsidered prior to submission of an Appeal Brief.

REMARKS

This Request for Pre-Appeal Brief Review is being filed in accordance with the provisions set forth in the Official Gazette Notices of July 12, 2005 and January 10, 2006. Pursuant to the Official Gazette Notices, this Request for Pre-Appeal Brief Review is being filed concurrently with a Notice of Appeal. Applicant respectfully requests reconsideration of the Application in light of the remarks set forth below.

Claims 1-9, 11-19, 22, 26, and 27 as being anticipated by Williams, et al. Claims 10, 12, 20, and 21 currently stand rejected under 35 U.S.C. §103(a) as being unpatentable over Williams, et al. in view of Official Notice. Claims 23-25 currently stand rejected under 35 U.S.C. §103(a) as being unpatentable over Jones III, et al. in view of Marsh, et al. Claim 28 currently stands rejected under 35 U.S.C. §103(a) as being unpatentable over Jones III, et al. in view of Williams, et al. In the prosecution of the present Application, the Examiner's rejections and assertions contain clear errors of law, including a failure to establish a prima facie case of obviousness. To assist the Panel in the review of this Request for Pre-Appeal Brief Review, Applicant submits the following brief summary for consideration.

In the Advisory Action of November 28, 2006 and the Final Action of September 6, 2006, the Examiner indicates that the Claims 1-22, 26, and 27 are basically anticipated by the Williams, et al. patent in that the graphs shown in FIGURE 1h of the Williams, et al. patent apply to anyone having the same age, same retirement income, and same contributions. In essence, the Examiner is stating that the individual user's peer group is only the individual user himself. However, the claimed invention requires showing a customer's standing within a selected peer group. It is readily apparent that a user's standing compared to himself is not the same as a

standing in a selected peer group. If all customers were identical, it would be fruitless to show how one customer stands in relation to other customers. The Williams, et al. patent merely provides a specific output for a particular individual with no comparison to any group let alone a selected peer group as required in the claimed invention. Moreover, the Williams, et al. patent fails to disclose how hypothetical changes affect a hypothetical standing of the customer within that selected peer group as required in the claimed invention. Thus, the Examiner's reliance on the Williams, et al. patent contradicts the features of the claimed invention.

Most notable of the legal errors present in the examination of the Application is a failure of the Final Action of August 22, 2006 to establish a prima facie case of obviousness of the claims in the Application with respect to Claims 23-25 and 28 rejected under 35 U.S.C. §103(a). There has been no mention of the three criteria for a prima facie case of obviousness as spelled out in M.P.E.P. §2143. The Examiner has not cited any language from the prior art that would suggest that the Jones III, et al. can be combined with the Marsh, et al. patent as proposed. The Examiner only provides a baseless subjective and conclusory "it would have been obvious" statement for modifying and combining the Jones III, et al. patent with the Marsh, et al. patent without providing any objective reasoning or citing any evidence of record to support such positions. In fact, the functionality of these cited patents are incompatible with one another. The Examiner has not cited any justification from these cited patents that their incompatible functionalities could even remotely be combined as has been proposed. In addition, the Examiner has not provided any reasons how the structure resulting from combining the Jones III, et al. patent with the Marsh, et al. patent would have any expectation of success let

alone a reasonable expectation of success. Moreover, the Examiner has failed to show that the proposed combination would even work for its intended purpose according to the claimed invention.

As for teaching the claimed invention, the Examiner has not been able to show that the Jones III, et al. or Marsh, et al. patents provide any capability for decision rules to be used to generate the targeted marketing reports let alone generating decision rules based on customer data as required by the claimed invention. The Jones III, et al. patent discloses receiving data from content providers accumulated based on past performance of consumers. The Jones III, et al. patent fails to disclose receiving data directly from customers as required by the claimed invention or the use of any data from a customer in the generation of decision rules. Though the Marsh, et al. patent discloses a user completing a survey, the Marsh, et al. patent also fails to disclose using any customer data in the generation of decision rules. at any of its nodes to determine whether traffic on a data path was received let alone an ability to provide such an indication along a reverse notification path as provided in the claimed invention.

Based on the remarks above, the Williams, et al., Jones III, et al. and Marsh, et al. patents are insufficient to support a rejection of the claims. Therefore, Applicant respectfully submits that the claims are patentably distinct from the Williams, et al., Jones III, et al., and Marsh, et al. patents, either alone or in combination.

CONCLUSION

Applicant has now made an earnest attempt to place this Application in condition for allowance. For the foregoing reasons and for other apparent reasons, Applicant respectfully requests allowance of all pending claims.

The Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of BAKER BOTTS L.L.P.

Respectfully submitted,
BAKER BOTTS L.L.P.
Attorneys for Applicant

Charles S. Fish
Reg. No. 35,870

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Correspondence Address:
2001 Ross Avenue, Suite 600
Dallas, Texas 75201-2980
(214) 953-6507
Customer Number: 05073